



UNITED STATES DEPARTMENT OF COMMERCE  
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EXAMINER	
SCHEINER, L	
ART UNIT	PAPER NUMBER
1812	22

DATE MAILED:

11/14/91

Below is a communication from the EXAMINER in charge of this application

COMMISSIONER OF PATENTS AND TRADEMARKS

ADVISORY ACTION

☐ THE PERIOD FOR RESPONSE:

- ☐ is extended to run \_\_\_\_\_ from the date of the Final Rejection
- ☐ continues to run \_\_\_\_\_ from the date of the Final Rejection
- ☐ expires three months from the date of the final rejection or as of the mailing date of this Advisory Action, whichever is later. In no event however, will the statutory period for response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date that the shortened statutory period for response expires as set forth above.

- ☒ Appellant's Brief is due in accordance with 37 CFR 1.192(a).
- ☒ Applicant's response to the final rejection, filed 10/10/91, has been considered with the following affect, but it is not deemed to place the application in condition for allowance:
1. ☒ The proposed amendments to the claim and/or specification will not be entered and the final rejection stands because:
- a. ☐ There is no convincing showing under 37 CFR 1.116(b) why the proposed amendment is necessary and was not earlier presented.
  - b. ☒ They raise new issues that would require further consideration and/or search. (See Note).
  - c. ☒ They raise the issue of new matter. (See Note).
  - d. ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - e. ☐ They present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

2. ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowed if submitted in a separately filed amendment cancelling the non-allowable claims.
3. ☒ Upon the filing of an appeal, <sup>the</sup> proposed amendment ☐ will be ☒ will not be, entered and the status of the claims in this application would be as follows:
- Allowed claims: \_\_\_\_\_
- Claims objected to: \_\_\_\_\_
- Claims rejected: 1-39
- However:
- a. ☐ The rejection of claims \_\_\_\_\_ on references is deemed to be overcome by applicant's response.
  - b. ☐ The rejection of claims \_\_\_\_\_ on non-reference grounds only is deemed to be overcome by applicant's response.
4. ☒ The affidavit, exhibit or request for reconsideration has been considered but does not overcome the rejection.
5. ☐ The affidavit or exhibit will not be considered because applicant has not shown good and sufficient reasons why it was not earlier presented.
- ☐ The proposed drawing correction ☐ has ☐ has not been approved by the examiner.
- ☐ Other

PLEASE SEE ATTACHMENT

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The affidavit has been considered but does not overcome the rejection because the use of three or more amplification probes does not render the invention unobvious in view of the cited art and no unexpected result or advantage has been shown when compared to said cited art. Examiner contends that although applicants repeatedly raise the "spurious blunt-end ligated amplification by-product" issue, said issue is not relevant to overcoming the rejections at hand. That is, that the "blunt-end ligation problem" has been overcome by the instant method is not pertinent to overcoming the rejection because it is obvious to do so (by employing three or more amplification probes) in view of Mullis et al, Carr and Whiteley et al. Applicants persist in arguing that their method overcomes a problem encountered in art not applied in the rejection (Orgel, and Wallace). The proposed amendments to the claims will not be entered because they raise the issue of new matter by the recital of "wherein said amplification probes.... contain about 2 to 30 nucleotides". "Contain about 2" reads on 1, and 1 nucleotide would be inoperable in the instant method because it cannot be hybridized to template prior to ligation, would otherwise read directly on Mullis et al, and said recitation cannot be found in the specification. Also at page 7, line 30 of the instant application, applicants specifically state that "each amplification probe is greater than one nucleotide in length". Further, applicants have not specifically pointed to supporting

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passages for their newly recited "contain about 2". The claims also raise new issues by their recital of "a known" and "at least three".

Laurie Scheiner/LAS  
November 13, 1991

LAS

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ART UNIT 187A  
*11/13/91*